

### **Remarks**

Upon entry of the above amendments this application will contain claims 1, 7, 10-12, 14, 15, 20-22, 36, and 37. The application was filed with claims 1-30. In a preliminary amendment filed 12 May 2006 claims 26-30 were canceled and new claims 31-35 were added. In a second preliminary amendment filed 19 October 2007 claims 18-19 and 23-35 were canceled. In this submission, claims 2-6, 8, 9, 13, 16, and 17, have been canceled and new claims 36 and 37 have been added. In light of the above amendments and the remarks below, it is believed that the application is in condition for allowance. Reconsideration leading to withdrawal of all rejections is requested.

#### **I. Election/Restriction**

Claims 2, 16 and 17 have been canceled in response to the restriction requirement and the applicant's election to prosecute the invention of Group 1. It is believed that claim 3 could also be included with the invention of Group 2, and consequently, this claim has been canceled. The applicants reserve their right to prosecute these claims in a continuing application. Claims 20-22, while withdrawn, have been retained in this application. The undersigned attorney requests rejoinder of these method claims upon indication of allowable compound claim(s).

#### **II. Rejections under 35 USC §112, Second Paragraph**

Claims 1 and 3-15 were rejected under 35 USC §112, second paragraph as indefinite. It was stated that the claims were drawn to ester prodrugs of the compounds without defining the structures of these prodrugs.

It is believed that the claimed invention, including prodrugs of the claimed compounds, is adequately defined in the application, specifically at pages 149 and 150. (Unless specifically noted to the contrary all citations to the present applications or specification refer to PCT application WO 05/051940, published 9 June 2005.) However, in order to advance the prosecution of this application, claims 1, 7, and 10-12 have been amended to delete reference to ester prodrugs. Claims 14 and 15 depend on claim 1. Claims 3-6, 8, 9, and 13 have been canceled. In light of the above amendments, withdrawal of the rejection of claims 1, 7, 10-12, 14, and 15 is requested.

#### **III. Rejections under 35 USC §112, first paragraph**

Claims 1 and 3-15 were rejected under 35 USC §112, second paragraph for lack of enablement. It was stated that the specification was not enabling for a skilled artisan to practice the invention commensurate with the scope of the claims.

Claims 1 and 7 have been amended by canceling reference to many of the variables. Specifically the variables, RP, RT<sub>3</sub>, RB, RB' and L<sub>TB</sub>, have been deleted and the formula or structure has been amended accordingly. Further the variables for R, R', RP<sub>3</sub>, L<sub>P1</sub>, L<sub>P2</sub>, Z<sub>P</sub>, and Z<sub>TB</sub> have been amended to more closely mirror the exemplified compounds. For support, see the Examples on pages 118-147 and claims 10-12. Additionally, claim 1 has been amended by inserting 1-ethyl-1-hydroxypropyl for the Z<sub>P</sub> group. Specific support for this amendment can be found in examples 26-31, pages 144-147. Claims 10-12, 14, and 15 depend from claim 1. Claims 3-6, 8, 9, and 13 have been canceled.

In light of the above claim amendments and comments, withdrawal of this rejection is requested.

#### IV. New Claims

New claims 36 and 37 have been added. Support for claim 36 can be found in the examples 7-9, 11, 12, 17-21, 24, and 25. Support for claim 37 can be found on pages 149 and 150. It is believed that these claims do not add new matter.

#### V. Conclusion

In light of the above amendments and comments withdrawal of all rejections and timely reconsideration leading to allowance of all pending claims are respectfully requested. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Submission or other issues that may be resolved in that fashion.

Respectfully submitted,

/James B. Myers/  
James B. Myers  
Attorney for Applicants  
Registration No. 42,021  
Phone: 317-276-0755

Eli Lilly and Company  
Patent Division  
P.O. Box 6288  
Indianapolis, Indiana 46206-6288  
22 August 2008